

## REMARKS

Claims 1-14 and 16-38 are pending in this application. In the Office Action dated September 26, 2006, claims 13 and 16 were rejected under 35 U.S.C. § 102(6) based on U.S. Patent No. 4,833,971 ("Kubik"). Claim 14 was rejected under 35 U.S.C. § 103(a) based on Kubik in view of U.S. Patent No. 5,611,304 ("Shinojima"). Claims 1-7, 12, 17, 18, and 20-24 were rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. 6,006,706 ("Kanzaki") in view of U.S. Patent No. 5,626,116 ("Reedy"). Claim 20 and 21 were rejected under 35 U.S.C. § 103(a) based on Kanzaki in view of Reedy and further in view of U.S. Patent No. 6,135,073 ("Feucht"). Claims 8-11 were rejected under 35 U.S.C. § 103(a) based on Kanzaki in view of Reedy and further in view of U.S. Patent No. 6,634,333 ("Fujieda"). Claims 1-7, 12, 17, 18, and 20-24 were rejected under 35 U.S.C. § 103(a) based on Kanzaki in view of Feucht and further in view of Reedy. Claim 19 was rejected under 35 U.S.C. § 103(a) based on Kanzaki in view of Feucht, further in view of Reedy, and further in view of Shinojima. Claims 8-11 were rejected under 35 U.S.C. § 103(a) based on Kanzaki in view of Feucht, further in view of Reedy, and further in view of 6,267,097 ("Urushihara").

### Rejections under 35 U.S.C. § 102 (b) & 103(a)

#### Claims 13, 14 and 16

Applicant respectfully requests the Examiner to withdraw the rejection of claims 13 and 16 as being anticipated by Kubik, and the rejection of claim 14 as being obvious under Kubik in view of Shinojima.

In order to properly anticipate Applicant's claimed invention under § 102, a single prior art reference must disclose each and every element of the claim at issue, either expressly or under principles of inherency. Further, "[t]he identical invention must be

shown in as complete detail as is contained in the . . . claim.” See M.P.E.P. § 2131.

Also, “[t]he elements must be arranged as required by the claim.” *Id.*

Kubik fails to disclose every recitation of independent claim 13. For example, claim 13, recites “a plunger having first and second ends reciprocatingly disposed in the housing, the plunger being movable between a first position at which the low pressure fluid inlet is in communication with the fluid outlet, and a second position at which the high pressure fluid inlet is in communication with the fluid outlet.” For all of this disclosure, the Office Action cites only to numeral 54. (Office Action, at 2-3.) Kubik teaches that numeral 54 is a “two-position double-pilot operated valve” (Kubik at col. 5, lines 12-13) and does not disclose that it has a plunger disposed in a housing and moveable “between a first position at which the low pressure fluid inlet is in communication with the fluid outlet, and a second position at which the high pressure fluid inlet is in communication with the fluid outlet” as claimed. Claim 13 is therefore allowable for at least the reasons discussed above.

Shinojima is not used to place either a high or low pressure source in communication with an outlet, and therefore cannot cure the above-noted deficiencies. Dependent claims 14 and 16 ultimately depend from claim 13, and therefore, are allowable for at least the reasons discussed above and in view of their additional recitations of novel subject matter.

#### **Rejections under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejection of claims 1-7, 12, 17, 18, and 20-24 based on Kanzaki in view of either Reedy or in view of Feucht, and further in view of Reedy, the rejection of claims 8-11 based on Kanzaki either in view of Reedy and further in view of Fujieda, or in view of Feucht, further in view of Reedy, and further in

view of Urushihara, and the rejection of claim 19 based on Kanzaki in view of Feucht, further in view of Reedy, and further in view of Shinojima. No *prima facie* case of obviousness has been established at least because the proposed combinations of Kanzaki, Reedy, and Feucht fails to disclose or suggest every one of the features recited in independent claims 1 and 17.

Applicants respectfully submit that the Section 103(a) rejection of independent claims 1 and 17 should be withdrawn because the Office Action does not establish a *prima facie* case of obviousness. As stated in M.P.E.P. § 2142, “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” To establish *prima facie* obviousness under 35 U.S.C. § 103(a), three requirements must be met. M.P.E.P. § 2143. First, the applied references must teach or suggest each and every element recited in the claim. Id. Second, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the references in a manner resulting in the claimed invention. Id. Third, a reasonable expectation of success must exist. Id. Moreover, the teaching or suggestion and the reasonable expectation of success “must both be found in the prior art, [and] not [be based on] applicant’s disclosure.” Id. (citing In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d (BNA) 1438 (Fed. Cir. 1991)).

The Examiner has failed to establish a *prima facie* case of obviousness because the combination of Kanzaki, Reedy, and Feucht does not teach each and every element recited in the claims. For example, Kanzaki does not teach a “controller adapted to receive the operation signal and transmit a control signal to the fluidically driven actuator and causing the valve to be open based on the operation signal” as recited in

independent claim 1. The apparatus of Kanzaki operates to **increase/decrease** lift of an intake valve 11 by either supplying or not supplying pressurized oil to a high pressure chamber 33 defined by a plunger 31 and piston 27 of a device 12 shown in Fig.

2. Kanzaki does not “cause the valve to **open**” (emphasis added) based on the operation signal, as claimed. Reedy and Feucht do not disclose controllers that are “adapted to receive the operation signal and transmit a control signal to the fluidically driven actuator,” and therefore do not cure this deficiency. Claim 17 contains the limitation “ the engine is configured to cause the valve to be open during the compression stroke” and is therefore similar in scope. Claim 1 and 17 are therefore allowable for this reason.

Claims 2-12 and 18-24 depend from and add additional features to one of independent claims 1 and 17. Accordingly, these claims are allowable over the combinations of references for at least the same reasons as the claims from which they depend. Applicants respectfully request that the Examiner withdraw the rejections applied to these claims.

#### **Allowable Subject Matter**

Applicants acknowledge with appreciation the Examiner’s indication of the allowability of the subject matter of claims 38 and 25-34.

#### **Conclusion**

Applicants respectfully request reconsideration of this application, the withdrawal of the claim rejections, and the timely allowance of the pending claims.

Applicants note that the Office Action contains several statements reflecting assertions about the pending claims and the cited references. Regardless of whether


any such statement is addressed specifically above, Applicants decline to subscribe to any assertion in the Office Action.

If there is any fee due in connection with the filing of this Reply, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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